REMARKS/ARGUMENTS

The Office Action mailed June 24, 2004 has been reviewed and carefully considered. Before the present Amendment, Claims 1-5 were pending, Claims 6-20 having been withdrawn by the Examiner in the June 24, 2004 Amendment. In the present amendment, none of pending Claims 1-5 are amended, and Claim 21 is added. Claim 21 comprises the limitations of Claims 1 and 5 as originally filed, and thus does not contain new matter. After entry of the present Amendment, Claims 1-5 and 21 will be pending, with Claims 1 and 21 being in independent form, Claims 6-20 having been withdrawn by the Examiner.

In the June 24, 2004 Office Action, the Examiner objected to the disclosure because the "Technical Field of the Invention" contained an improper reference to the preamble of the first independent claim. However, this reference was removed in applicant's previous Amendment, filed on April 15, 2004. Withdrawal of the objection is respectfully requested.

In the June 24, 2004 Office Action, the Examiner alleged that Claims 6-20 (added in the April 15, 2004 Amendment) were directed to an invention independent or distinct from the invention originally claimed, and, based on this finding, withdrew Claims 6-20 from consideration.

Applicants traverse the Restriction Requirement for at least the following reasons. There are two criteria for making a proper Restriction Requirement (see MPEP §803.01):

(A) The inventions must be independent or distinct as claimed; and

(B) There must be a serious burden on the Examiner to examine the inventions.

Regarding criteria (A), it is difficult for applicant to determine what the Examiner's argument is for there being separate and distinct inventions, and, therefore, it is difficult to determine whether the Examiner has satisfied criteria (A) or not. The Examiner indicates that the independent claims recite different words, as they should, but provides no indication as to why these different words require a finding that the claims cover different inventions.

Specifically, the Examiner states that "in the original claims (claims 1-5), cell selection message is initiated by the network so as to change the mobile station to a cell-connected state and the selected cell to be used by the mobile station in that cell-connected state" (Office Action, pages 2-3). To begin with, this is not an accurate description of Claims 1-5. Claim 1 recites "selecting, by the network, a cell to be suggested as the cell for use by the mobile station in the cell-connected state" and ""indicating, by the network, said selected cell to be suggested by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell-connected state". The network does not "initiate" a "cell selection message" in Claim 1, but rather indicates a suggested cell by attaching the cell's identification information as a parameter to a message that initiates a change of the mobile station to the cell-connected state. There is no "cell selection message" in Claim 1, only a message that has identification information of a suggested cell attached. In other words, there are no limitations on what type of message to which the parameter might be attached, except that the message initiates a change to the cell-connected state. On a very basic level, "initiating a cell selection message" is not equivalent to the steps of "selecting a cell to suggest" and "indicating the suggested cell by attaching its identity as a parameter to a message".

Most importantly in the current context, the description does not even mention the term "suggest" as it appears in Claim 1. This is important for at least two reasons. First, the concept of a suggested cell is common to all the claims, both pending and withdrawn. In other words, it is an element that ties all of the claims together. Second, the fact that the network is **suggesting** the cell be used by the mobile station, but **not directing (i.e., commanding)** the mobile station to select the cell, is an important distinction. To describe the "cell to be suggested as the cell for use by the mobile station in the cell-connected state", as recited in Claim 1, as the "cell to be used by the mobile station", as described in the June 24, 2004 Office Action, misses the fact that the selected cell is only suggested for use, not commanded.

The Examiner states that "in the newly added claims (claims 6-20), a radio access network is provided to select a cell [to be used by] by a mobile station in the common channel state after the mobile station is transitioned from a dedicated channel state to the common

channel state, whose channel state is different from what is provided in the original claims" (Office Action, page 3). Once again, this is not exactly an accurate description of what is recited in Claims 6-20. The important element of suggestion is completely missing in this description, i.e., the network selects a cell to be suggested to the mobile station, not the cell that will necessarily be used by the mobile station.

Although both the pending and withdrawn claims recite a network which suggests a cell to be used by a mobile station after switching to another channel state, the Examiner appears to grab on the fact that the channel state into which the mobile station transitions has a different name in Claim 1 ("the cell-connected state") than in Claim 6 ("the common channel state") as the reason why these two claims recite distinct and independent inventions. The Examiner makes no attempt to determine the relationship between the two terms (is one a genus and the other a species? do the two categories overlap? are they mutually exclusive?), nor to determine the substantive content of either term.

Thus, it appears (because no other reason is given) that the Examiner's reason for deciding that Claims 1-5 recite a separate and independent invention from Claims 6-20 is that the phrase "cell-connected state" is used in Claim 1, while the phrase "common channel state" is used in Claim 6. No explanation is given as to why the use of these two phrases causes the Examiner to believe that the claims recite distinct and independent inventions. No attempt is made to define the two phrases, or their scope.

It is respectfully submitted that the Examiner has not provided a sufficient statement of his reasons for finding distinct and independent inventions. See, e.g., M.P.E.P. §816 ("The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. For example, relative to combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.").

Furthermore, the Examiner has failed to identify the separate inventions, briefly describe each separate invention, specify which claims correspond to which invention, or provide any of the substantive details supporting a Restriction Requirement. See, e.g., M.P.E.P. §816 ("The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass.").

Applicants respectfully submit that the Examiner has not provided sufficient reasons for finding distinct and independent inventions. It should be noted that applicants are not providing a substantive response to the Restriction Requirement (i.e., whether the pending and withdrawn claims recite distinct and independent inventions), as applicants have not received the substantive reasoning for making the Restriction Requirement. As such, this response should not be misconstrued as an assertion by applicants that the claims do, or do not, recite separate and distinct inventions.

In addition, applicants traverse the Restriction Requirement because the Examiner has failed to make a *prima facie* showing of a serious burden, i.e., criteria (B) above. As stated in the MPEP, a serious burden may be *prima facie* shown by the Examiner "by appropriate explanation of separate classification, or separate status in the art, or a different field of search" (MPEP, §803.01). Because the Examiner has failed to show any of these, or even to make any statement concerning the serious burden criteria, the Examiner has not made a proper Restriction Requirement.

Although the Examiner has elected an alleged species as required by 35 U.S.C. §121, applicant respectfully traverses the requirement and requests reconsideration under 37 C.F.R. §1.143 and either a sufficient explanation of the reasons for the Restriction Requirement or the withdrawal of the Restriction Requirement, in light of the remarks made above. If the next Office Action contains neither a more detailed explanation nor a withdrawal, applicants

respectfully request that the Examiner make the Restriction Requirement final, so that applicants can petition for review of the Restriction Requirement under 37 C.F.R. §1.144.

In the June 24, 2004 Office Action, the Examiner rejected Claims 1-5 under 35 U.S.C. §103(a) as unpatentable over the admitted prior art (APA) in view of *Wallstedt Jr. et al.* (US 8,854,981). Applicants respectfully disagree..

Independent Claim 1 of the present application recites the steps of: "selecting, by the network, a cell to be suggested as the cell for use by the mobile station in the cell-connected state" and "indicating, by the network, said selected cell to be suggested by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell-connected state".

In the prior art, the mobile station selected the cell to be initially used in the cell-connected state, and then transmitted a message to the network informing the network of the selected cell using a channel of the selected cell (see, e.g., page 3, lines 23-32, present application). This solution is problematic because (i) it causes too much signaling, and (ii) the mobile station does not know all the conditions of the system, and might choose a cell which is less than optimal (see, *id.*). The invention claimed in Claim 1 mitigates this problem by having the network suggest a cell for the mobile station to use when it enters the cell-connected state; furthermore, the network identifies the suggested cell by attaching its identification to the very message which is going to cause the mobile station to enter the cell-connected state.

In his rejection, the Examiner asserts that "[i]ndicating the selected cell by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell connected state would have been inherent in the APA system" (Office Action, page 4). Oddly enough, the Examiner cites, as support for this assertion, the passage which described the problems with the prior art cited above.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d

1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). There is nothing in the passage cited from the present application which makes it clear that "indicating the selected cell by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell connected state " is ***necessarily*** present. In fact, the passage expressly indicates that, in the prior art, the network did ***not*** suggest a preferred cell to the mobile station because the passage states that one of the problems with the prior art is that the mobile station does not know what cell the network prefers ("Further, the UE may not know all details which affect the optimality of the cell selection. For example, the network may for various reasons prefer that the UE select a macro cell, or a cell that is controlled by the SRNC").

Furthermore, there is nothing in the APA that indicates that attaching the cell identification information to the very message which will initiate the change in channel state is necessarily present in the prior art system described. Moreover, as discussed above, the Examiner completely leaves out the concept of ***suggestion*** which is an important element in the invention claimed in independent Claim 1 of the present application. How is the concept of the network suggesting a cell for the mobile station to use in the cell-connected state necessarily present in the APA?

In *Wallstedt Jr. et al.*, the mobile switching center (MSC) of a cellular network initiates a handoff measurement process when a base station indicates that the strength of the signal from a mobile station in its area has gone below a certain threshold (see, col. 1, line 60, to col. 2, line 25). The MSC orders the base stations on the "neighbor cell list" associated with the current cell to measure the strength of the mobile station in order that the MSC can determine which base station is receiving the strongest signal. Based on these measurements, the network determines to which base station the mobile station connection will be "handed off". According to *Wallstedt Jr. et al.*, the base stations on the neighbor cell list were fixed in the prior art, and could only be changed manually by the system operator. *Wallstedt Jr. et al.* purports to teach a system in which the "neighbor cell list" is dynamically reconfigured as the system operates, i.e., the base stations on the list change as conditions in the cell change (see, e.g., col. 4, lines 28-42).

Thus, *Wallstedt Jr. et al.* is directed to dynamically maintaining a list of cells neighboring a certain cell so that handoff operations are more efficient. By contrast, independent Claim 1 of the present application is directed towards suggesting a cell to a mobile station on which to maintain a cell-connected state channel (by adding the cell identification information to a message which will initiate the change to the cell-connected state). Although it would be possible for a network according to an embodiment of the present invention to use a neighbor cell list to select a cell to suggest to the mobile station, *Wallstedt Jr. et al.* neither teaches nor suggests a network which suggests a cell for use by a mobile station in the cell-connected state. Furthermore, *Wallstedt Jr. et al.* neither teaches nor suggests attaching a suggested cell's identification information as a parameter to a message which will initiate a channel state change in the mobile station

At least because the combination of APA and *Wallstedt Jr. et al.* neither teaches nor suggests the steps of "selecting, by the network, a cell to be suggested as the cell for use by the mobile station in the cell-connected state" and "indicating, by the network, said selected cell to be suggested by attaching cell identification information as a parameter to a message initiating a change of the mobile station to the cell-connected state", as recited in Claim 1 of the present application, Claim 1 is patentable over the combination of APA and *Wallstedt Jr. et al.*. Withdrawal of the rejection is respectfully requested.

At least through their dependence on Claim 1, which is believed to be patentable over the combination of APA and *Wallstedt Jr. et al.*, dependent Claims 2-5 are also believed to be patentable over the combination of APA and *Wallstedt Jr. et al.*. Withdrawal of their rejection is also respectfully requested.

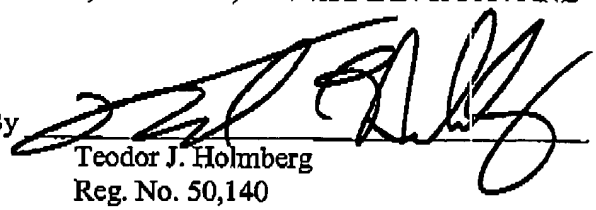
In the June 24, 2004 Office Action, the Examiner stated that Claim 5 "would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims" (Office Action, page 6). There was no §112, second paragraph, rejection in the June 24, 2004 Office Action. Comprising the limitations of Claims 1 and 5, independent

Claim 21 has been added in the present Amendment. At least because the Examiner has indicated that such a combination of limitations was patentable over the prior art, applicants respectfully submit that newly added independent Claim 21 is in condition for allowance, which is respectfully requested.

At least for the foregoing reasons, it is believed that all of the pending claims are in condition for allowance, which is respectfully requested.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By 

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